



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,750	12/10/2001	Shahram Mostafazadeh	NSCIP226R	5469
58766	7590	10/06/2008		
Beyer Law Group LLP P.O. BOX 1687 Cupertino, CA 95015-1687			EXAMINER STARK, JARRETT J	
			ART UNIT 2823	PAPER NUMBER
			MAIL DATE 10/06/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/016,750
Filing Date: December 10, 2001
Appellant(s): MOSTAFAZADEH ET AL.

Eric Yoon
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/9/2008 appealing from the Office action mailed 5/13/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

This application is a reissue of U.S. Patent No. 6,034,423.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 251

Claims 11-22 rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The Applicant's Oath filed 6/12/2007 states the " original claim set was in error and partially inoperative at least in part because all of the originally granted

Art Unit: 2823

independent claims specifically required that each of the leads include a 'circular portioned formed as an attachment pad' and that such limitations are unduly limiting..." The newly submitted claims omit this limitation from the new claims 11-22. It is pointed out that this limitation was added to the claims with the amendments filed 7/12/1999 and argued to be both critical to the invention and distinguishing over the prior art.

Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

(10) Response to Argument

Applicant's arguments filed 9/9/2008 have been fully considered but they are not persuasive.

Appellants argue claims 11-14 are not an improper recapture because the newly presented claims are narrower than the claims originally patented. However in response, during the original prosecution of the previous allowed claims, it was argued by the Applicants that the shape/structural limitation "circular portioned formed as an attachment pad" was the critical distinguishing feature of the allowed claims. For this reason the Office allowed and issued the original claims. Therefore, this feature must be present in the claims of the reissue application in order to avoid being rejected under 35 U.S.C. 251 as being

Art Unit: 2823

an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

The currently pending claims none the less are still directed to the same originally claimed and allowed invention, therefore the pending reissue claims require the originally claimed critical and distinguishing limitation of a "circular portioned formed as an attachment pad".

Argument to dependent claims 15-17 rely upon the arguments of claim 11, therefore the response is the same as presented supra.

Appellants argue claim 19 are not an improper recapture because the newly presented claims are narrower than the claims originally patented. However in response, during the original prosecution of the previous allowed claims, it was argued by the Applicants that the shape/structural limitation "circular portioned formed as an attachment pad" was the critical distinguishing feature of the allowed claims. For this reason the Office allowed and issued the original claims. Therefore, this feature must be present in the claims of the reissue application in order to avoid being rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

The currently pending claims none the less are still directed to the same originally claimed and allowed invention, therefore the pending reissue claims

Art Unit: 2823

require the originally claimed critical and distinguishing limitation of a "circular portioned formed as an attachment pad".

Argument to dependent claims 20-22 rely upon the arguments of claim 19, therefore the response is the same as presented supra.

Appellants argue claim 23 are not an improper recapture because the newly presented claims are narrower than the claims originally patented. However in response, during the original prosecution of the previous allowed claims, it was argued by the Applicants that the shape/structural limitation "circular portioned formed as an attachment pad" was the critical distinguishing feature of the allowed claims. For this reason the Office allowed and issued the original claims. Therefore, this feature must be present in the claims of the reissue application in order to avoid being rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

The currently pending claims none the less are still directed to the same originally claimed and allowed invention, therefore the pending reissue claims require the originally claimed critical and distinguishing limitation of a "circular portioned formed as an attachment pad".

Art Unit: 2823

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Jarrett J Stark/
Examiner, Art Unit 2823
September 23, 2008

Conferees:

/Jarrett J Stark/
Examiner, Art Unit 2823

/Matthew S. Smith/
Supervisory Patent Examiner, Art Unit 2823

/T C Patel/
Supervisory Patent Examiner, Art Unit 2839